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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,497	07/01/2003	Rikke Mikkelsen	Q76406	1689

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EXAMINER

PRATT, HELEN F

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,497

Applicant(s)

MIKKELSEN ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 34-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-33 drawn to a process, classified in class 426, subclass 1.
- II. Claims 34-47, drawn to an apparatus, classified in class 99, subclass ++.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to make other products such as plastics of different sizes.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Sheldon on 3-16-06 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34-47 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 provides for the use of the methods of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 33 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernatz et al. (6,551,643) in view of Phillips (4,117,645) and Corriveau (WO 03011045).

Bernatz et al. disclose a method of making chewing gum containing a gum base and other ingredients such as a sweetener (claim 5) as claimed (abstract and col. 4,

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lines 30-33, lines 48-70, col. 6, lines 40-70, col. 7, lines 1-5, col. 9, lines 6-15, col. 9, lines 20-35). Claims 1 and 4 differ from the reference in the step of conveying the extruded gum granules to a tableting machine and pressing the gum granules into compressed chewing gum tablets. However, Corriveau et al. disclose that it is known to tablet gum made from gum chips. No patentable distinction is seen at this time between chips and granules as they can both be pressed into another form. Therefore,, it would have been obvious to press a composition as disclosed by the Corriveau in the process of Bernatz et al. Also Phillips disclose that it is known to pelletize gum before making it into a final product by extruding it into a liquid medium (abstract). The pelletized gum is then transported to its final destination before being further processed into the desired gum formulation. Therefore, it would have been obvious to further process gum pellets or granules as shown by Phillips in the process of Bernatz et al.

Claims 2-3 further require that the gum granules contain particular amounts of gum base. However, as it is known to use 70% gum base, it would have been obvious to use more gum base and less of the other ingredients, depending on the product desired.

The gum base and sweetener are mixed together as in step b (col. 4, lines 8-14, col. 9, lines 9-35).

Claims 7-15 further require particular amounts of sweetener and flavor. The reference discloses sorbitol in amounts of 20% and intense sweetener's. Menthol is disclosed in amounts from 1.50% to 2% (col. 9, lines 20-35).

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Claims 16-18 further require particular sizes of cut granules. Bernatz discloses die plate apertures from 2.mm to 3.2 mm (col. 9, liens 9-15).

Claim 19 further requires die plate openings with two different sizes. Bernatz et al. disclose die plates having multiple uniform apertures (col. 9, lines 6-11). Ream et al. disclose that it is known to use 90% particles of chewing gum having a size of 0.5 to 6 mm.

Claim 20-24 further requires that the granules have two different diameter sizes, and claims 21-24 various sizes. Corriveau discloses that it is known to make gum chips in sizes from 0.5mm to 6.0 mm (0033). The reference discloses that the difference in particle size of the gum components and the tableting media results in a non-homogeneous distribution of gum components (003(when compacted, i. e. tableted). Therefore, it would have been obvious to use the chip sizes and the different sizes of chips as disclosed by Corriveau in the process of Bernatz to make granules of varying sizes.

Claim 25 further requires removing the surface liquid from the extruded granules, claim 26, classifying the extruded granules. Bernatz et al. disclose using a centrifugal dryer to separate the water from the product as in claim 25(abstract) and classifying the gum products by allowing the gum products to pass through a screen, which rejects oversized products (col. 5, lines 55-70).

The limitations of claims 27, 28 have been disclosed above and are obvious for those reasons.

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Claims 29 and 30 further require that the tablets contain from 30-45% of the gum base. Corriveau et al. disclose that the gum component can be from 40-60% of the tableted gum. Therefore, it would have been obvious to use known amounts of gum base in the process of the combined references.

Claim 32 further requires various ingredients for the coating. Corriveau et al. disclose that the tableting medium, which is considered to be a coating, can be various ingredients such as color, emulsifier, flavoring (0043). At any rate coating for gum pieces are well known as in CHICKLETS (tradename). Therefore, it would have been obvious to use known coatings in the claimed composition and to use the coating of Corriveau in the process of the combined references for its function as a coating.

Claim 33 is to the use of the methods, which have been disclosed above and are obvious for those reasons.


HELEN PRATT
PRIMARY EXAMINER